REMARKS/ARGUMENTS

In view of the following remarks, the applicants respectfully submit that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 103

Claims 2-8, 11-17, 20-24, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,994,710 ("the Knee patent") in view of U.S. Patent No. 4,797,544 ("the Montgomery patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 6, 8 and 12 are not rendered obvious by the Knee and Montgomery patents because one skilled in the art would not have combined these patents as proposed by the Examiner. The Examiner concedes that the Knee patent fails to teach a second light source, and that the second light source determines position information (while the first light source captures a

plurality of image parts). (See Paper No. 20071120, page 3.) The Examiner relies on the Montgomery patent to compensate for this admitted deficiency of the Knee patent. Finally, the Examiner concludes:

> It would have been obvious to one with ordinary skill in the art at the time the invention was made to include a second light source of Montgomery with the capturing device of KNEE in order to have each light source provide a unique purpose in the overall scheme of the mouse. The advantage of having each light source provide a different purpose of function to the mouse is that this allows greater flexibility in the design of the mouse, since each light source may be adjusted accordingly in order to better carry out its unique purpose (Montgomery, column 1, lines 50-55).

(Paper No. 20071120, page 3) The applicants respectfully disagree.

First, the Examiner cites Figure 6, item 151 and column 5, lines 28-31 of the Montgomery patent as teaching a second light source that determines position. However, the second light source is not for determining position, but rather for determining "the angle at which [second mouse] 150, and scanner 15 is held." (Column 5, lines 34 and 35) However, the device discussed in the Knee patent is ***already capable*** of measuring both translation and ***rotation*** of the scanning mouse. (See, e.g., the Abstract.) ***One skilled in the art would not have added an additional component to the device of the Knee patent in order to accomplish a function that the unmodified device of the Knee patent can already perform.***

Thus, one skilled in the art would not have combined the Knee and Montgomery patents as proposed by the Examiner for at least this first reason.

Further, position detectors in the Montgomery patent rely on external indicia (e.g., a transparency 18 overlaying a page 11 being scanned, providing horizontal and vertical lines (in addition to text) on a page 11, providing marks 210 of a mechanical constraint 200 along which a scanner 202 is dragged, providing lines 260 on a screen 252 along which a scanner 254 is moved, etc.) One skilled in the art would not have been motivated to modify the Knee patent with position detection means, such as those discussed in the Montgomery patent, requiring transparencies, horizontal and vertical marking lines, or marked constraints or screens. Thus, one skilled in the art would not have combined the Knee and Montgomery patents as proposed by the Examiner for at least this second reason.

Furthermore, the Examiner's conclusion that, "The advantage of having each light source provide a different purpose of function to the mouse is that this allows greater flexibility in the design of the mouse, since each light source may be adjusted accordingly in order to better carry out its unique purpose" is not supported. Although the Examiner cites column 1, lines 50-55 of the Montgomery patent, this portion of the Montgomery patent merely concerns using the second position sensor to get a second position, which when used together with a first position, provides an angle of the optical scanner relative to the printed text on a page. That is, the cited section would indicate to one skilled in the art that two identical position sensors are used. Thus, one

skilled in the art would not have combined the Knee and Montgomery patents as proposed by the Examiner for at least this third reason.

Dependent claims 7 and 11 further recite that the light emitted from the first light source has a larger angle of incidence with the surface than the light emitted from the second light source. The Examiner concedes that even her proposed combination does not teach that light emitted from the first light source has a larger angle of incidence with the surface than the light emitted from the second light source. To compensate for this admitted deficiency in the Examiner's proposed combination, the Examiner (1) takes official notice that it is well known to have a second light source positioned at a different angle from the first light source (citing U.S. Patent No. 6,657,183), and (2) concludes that it would have been obvious to position the first light source to have a higher angle of incidence with the surface than the second light source in order to reflect more light to a wider area, thereby allowing a greater image area to be captured. The applicants respectfully take issue with each of these points.

First, the patent cited by the Examiner as documenting that it is well known to have a second light source positioned at a different angle from the first light source (6,657,183) is apparently includes a typographical error since this patent is issued to Yamamoto (not Anderson) and is apparently directed to a non-analogous art. Thus, the applicants hereby rebut the Examiner's official notice and request that she make any

such well know art of record in any future office action to afford the applicants the opportunity to review it.

Second, the Examiner concludes that it would have been obvious to position the first light source to have a higher angle of incidence with the surface than the second light source in order to reflect more light to a wider area, thereby allowing a greater image area to be captured. Recall, that the Examiner relies on the Montgomery patent as teaching a second light source. This second light source is used to count the number of horizontal and/or vertical lines (indicia) crossed during a scanning operation. The Examiner has not established that the second light source would have a lower angle of incidence than a light source for scanning. Indeed, based on the function of the second light source in the Montgomery patent, the applicants respectfully submit that one skilled in the art would not have been motivated to position it to have a low angle of incidence with the surface.

Thus, dependent claims 7 and 11 are not rendered obvious for at least the foregoing additional reasons.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain ***only*** to the specific aspects of the invention ***claimed***. Any claim amendments or cancellations, and any arguments, are made

without prejudice to, or disclaimer of, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

April 4, 2008

John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 936-1400

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

John C. Pokotylo
Type or print name of person signing certification

Signature

April 4, 2008
Date